

REMARKS/ARGUMENTS

Claims 7-8, 11-12 and 19-24 are pending in this application. The claims have been amended for clarity, and new dependent claim 24 has been added. The amendments are supported throughout the specification and in the Examples, and no new matter has been added. Applicant respectfully requests allowance of the amended claims in view of the remarks herein.

Rejections under 35 USC § 112

Claims 20-23 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, claim 20 and claim 21 are rejected as allegedly being improper dependent claims. Claim 20 has been amended and the compound having a methyl in the 5-position of the pyrimidine has been deleted.

Claims 22 and 23 are also rejected as allegedly reciting species outside the scope of the broadest claim 7. As claims 22 and 23 are independent claims, Applicant respectfully requests that this rejection be withdrawn. As indicated in the previous Office Action dated June 8, 2010, all compounds in claim 21 (which includes compounds in independent claims 22 and 23) would be allowable if rewritten in independent form.

Based on the above, Applicant submits that claims 20-23 are definite, and respectfully requests that this rejection be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 7-8, 11-12 and 19 are rejected under 35 U.S.C. § 102(e), as allegedly being anticipated by Chyba *et al.*, U.S. 7,125,997. The claims as amended are not anticipated, and Applicant respectfully requests that this rejection be withdrawn.

Rejections under 35 U.S.C. § 103

Claims 7-8, 11-12 and 19 are rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over U.S. 7,125,997. Applicant disagrees.

As stated under 35 U.S.C. § 103(c)(1), "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section

120 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” As the cited art and the present application were owned by the same entity (i.e., IRM LLC) at the time the claimed invention was made, U.S. 7,125,997 shall not preclude patentability of the claimed invention and Applicant respectfully requests that this rejection be withdrawn.

Claims 7-8, 11-12 and 19 are also rejected under 35 U.S.C. § 103(a), as allegedly being unpatentable over Bhatt *et al.*, (U.S. 7,419,984). As amended, claim 7 recites that R¹ is -NHR⁷, wherein R⁷ is phenyl substituted with a halo-substituted C₁₋₄alkoxy, or R¹ is pyridinyl. Bhatt *et al.* give no suggestion or teaching to produce the presently claimed invention; the claims as amended are non-obvious, and Applicant respectfully requests that this rejection be withdrawn.

Conclusion

In view of the foregoing, Applicant submits that pending claims 7-8, 11-12 and 19-24 are now allowable. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned attorney at 858-812-1539.

In the event that the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 50-1885 referencing docket No. PAT034369-US-NP.

Respectfully submitted,

/Emily Tongco Wu, Reg. No. 46,473/

Emily Tongco Wu, Ph.D.
Reg. No. 46,473

January 6, 2011

Customer No.: 29490
Tel: (858) 812-1539
Fax: (858) 812-1909